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EXAMINER

KARIKARI, KWASI

ART UNIT PAPER NUMBER

2617

DATE MAILED: 08/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/523,544

Applicant(s)

DAVIDSON, BRIAN

Examiner

Kwasi Karikari

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 40-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 40-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 2617.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 02/09/2006 is in compliance with the provision of 37 CFR 1.97, has been considered by the Examiner, and made of record in the application file.

3. Claims 44-46,48,51-54,56-59,61-63 have been currently amended.

4. Claims 64-66 have been added.

Response to Arguments

5. Applicant's arguments, see Remarks, filed 05/03/2006, with respect to the rejection(s) of claim(s) 40-63 under 35 U.S.C. 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Sasakura et al. (U.S 6,151,493), Pons et al. (5,345,221) and Rohrbach (U.S 5,898,783).

Specification

6. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

a. Claims 54,56,57-59,61-63 recite the limitation of "partial disablement" and the specification only provides antecedent basis for "at least partial disablement" The specification does not provide antecedent basis for "partial disablement" only.

Furthermore, the specification fails to differentiate the difference between the "at least partial disablement" and the "partial disablement".

b. Furthermore, the applicant cited "In response to activation... send a disabling SMS messageas a normal a normal telephone." (see page 7, lines 17-19). The applicant fails to show where the SMS message was sent. The applicant later on stated that "the message sent to the network". Such statement "the network" was not mention beforehand and does not provide antecedent basis for "the message sent to the network". For purposes of applying prior art, all embodiments are being examined as understood from applicant' specification.

Claim Objections

7. Claims 41-46,49-53,55-58,60-62 and 64-66 objected to because of the following informalities: Applicant uses "A portable device" in claims 41-46,49-53,55-58,60-62 and 64-66. The Examiner suggests using "The portable device" as making reference to the

previously cited claimed limitations "A portable device" in the independent claims.

Appropriate corrections are required.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

a. Claim 54 and 59 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amended claimed limitations "radio frequency wireless couple", in claims 54 and 59 are not clearly described in the specification as originally filed and this constitute new matter.

b. The amended claimed limitations "partial disablement", in Claims 54,56,57-59, 61-63, are again not clearly described in the specification as originally filed and this constitute new matter. All claims that depend on the above rejected claims are also rejected for fully incorporating the deficiencies of the above rejected claims from which they depend. Appropriate corrections are required

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

In claim 40, the applicant recites the limitations “the release”, however, there are insufficient prior antecedent basis for these limitations in the claims. All claims that depend on the above rejected claims are also rejected for fully incorporating the deficiencies of the above rejected claims from which they depend. Appropriate corrections are required.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 54-56,59-61 and 63 are rejected under 35 U.S.C. 102(b) as being anticipated by Sasakura et al. (U.S 6,151,493), (hereinafter Sasakura)

Regarding **claims 54 and 59**, Sasakura discloses portable device (see Fig. 1) comprising:

unauthorized separation detection means arranged to detect the unauthorized separation of the portable device from a counterpart device worn by a person (owner of the cell phone 30); and

control means arranged (see col. 8, lines 10-32) to effect partial disablement of the portable device in response to the unauthorized separation of the portable device, wherein the portable device and the counterpart device are arranged to form a radio frequency wireless couple (communication between unit 10 and cell phone 30, see Fig. 1) the diminution of which is detectable by the unauthorized separation detection means (cell phone 30 is disabled when separated for a predetermined distance, see col. 9, lines 7-29 and col. 3, lines 44-59).

Regarding **claim 55**, as recited in claim 54, Sasakura teaches that the portable device comprises a cellular radio transceiver (see items 31a and 33d in Fig. 1).

Regarding **claim 56**, recited in claim 55, Sasakura teaches that the control means is arranged to effect partial disablement of the portable device by controlling the cellular radio transceiver to transmit a disabling message instructing the at least partial disablement of the device (cell phone 30 is disabled when separated for a predetermined distance, see col. 9, lines 7-29).

Regarding **claim 60**, as recited by claim 59, Sasakura discloses that the counterpart device comprises a cellular radio transceiver or mobile telephone

(see unit10 and cellular phone 30, Fig. 1).

Regarding **claim 61**, as recited in claim 60, Sasakura teaches, wherein the counterpart device comprises the control means (see col. 8, lines 10-32) is arranged to effect partial disablement of the counterpart device by controlling the cellular radio transceiver (see items 31a and 33d in Fig. 1) to transmit a disable message instructing the partial disablement of the counterpart device (cell phone 30 is disables when separated for a predetermined distance, see col. 9, lines 7-29).

Regarding **claim 63**, discloses a portable device (see unit10 and cellular phone 30, Fig. 1) comprising:

unauthorized removable means arranged to detect the unauthorized separation of the portable device from a person (owner of the cellular phone 30) porting the device (30) (see col. 3, lines 44-59 and Fig. 1)

control means arranged (see col. 8, lines 10-32) to effect partial disablement of the portable device in response to the unauthorized removal of the device from the person porting the device (cell phone 30 is disables when separated for a predetermined distance, see col. 9, lines 7-29).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 40-45,48-52 and 64 are rejected under U.S.C. 103(a) as being unpatentable over Sasakura et al. (U.S 6,151,493), (hereinafter Sasakura) in view of Pons et al. (5,345,221), (hereinafter Pons).

Regarding claims **40 and 48**, Sasakura discloses a portable device (see Fig. 1) comprising:

unauthorized separation detection means arranged to detect the unauthorized separation of the portable device from a person (see col. 3, lines 44-59)

and control means arranged to effect at least partial disablement of the portable device in response to the unauthorized separation of the portable device authorized separation detection means (see col. 8, lines 10-32) are means for detecting the release and connecting the portable device to a person (cell phone 30 is disables when separated for a predetermined distance, see col. 9, lines 7-29); but fails to teach a releasable connector.

Pons teaches a "releasable connector" (separation of armed modules which are coupled together by fabric fastener or magnets, see col. 2, line 46- col. 3, line 8 and col. 6, lines 38-64).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Pons with the system of Sasakura for the benefit of achieving a

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system that includes two physical modules that cause an electrically closed circuit and produce an alarm when pulled away from each other (see col. 2, line 46- col. 3, line 8 and col. 3, lines 20-64).

Regarding **claims 41 and 49**, as recited in claims 40 and 48, Sasakura fails to teach that the releasable connector comprises a strap.

Pons teaches that the releasable connector comprises a strap (coupling of the first and the second modules with lanyard or fabric fastener, see col. 2, lines 46-64 and col. 3, lines 9-51).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Pons with the system of Sasakura for the benefit of achieving a system that includes two physical modules that cause an electrically closed circuit and produce an alarm when pulled away from each other (see col. 2, line 46- col. 3, line 8 and col. 3, lines 20-64).

Regarding **claims 42 and 50**, as recited in claims 40 and 48, Sasakura fails to teach that the releasable connector is released by severance.

Pons teaches that the releasable connector is released by severance (snatching or pulling of the valuable item, see col. 6, lines 58-64).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Pons with the system of Sasakura for the benefit of achieving a system that includes two physical modules that cause an electrically closed circuit and

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produce an alarm when pulled away from each other (see col. 2, line 46- col. 3, line 8 and col. 3, lines 20-64).

Regarding **claim 43**, as recited in claims 40, Sasakura fails to teach the interruption of a closed conductive path via the releasable connector.

Pons teaches the interruption of a closed conductive path via the releasable connector (see col. 5, lines 20-47).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Pons with the system of Sasakura for the benefit of achieving a system that includes two physical modules that cause an electrically closed circuit and produce an alarm when pulled away from each other (see col. 2, line 46- col. 3, line 8 and col. 3, lines 20-64).

Regarding **claim 44**, as recited in claim 40, Sasakura further teaches that the portable device comprises a cellular radio transceiver (see items 31a and 33d in Fig. 1).

Regarding **claim 45**, recited in claim 44, Sasakura further teaches that the control means is arranged to effect at least partial disablement of the portable device by controlling the cellular radio transceiver to transmit a disabling message instructing the at least partial disablement of the device (cell phone 30 is disabled when separated for a predetermined distance, see col. 9, lines 7-29).

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Regarding **claim 52**, as recited in claim 48, Sasakura further teaches radio transmitter (items 31a and 33d in the cell phone 30, see Fig. 1) and control means is arranged to control the radio transmitter to send a message (cell phone 30 is disabled when separated for a predetermined distance, see col. 9, lines 7-29); but fails to teach a releasable connector.

Pons teaches a "releasable connector" (separation of armed modules which are coupled together by fabric fastener or magnets, see col. 2, line 46- col. 3, line 8 and col. 6, lines 38-64).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Pons with the system of Sasakura for the benefit of achieving a system that includes two physical modules that cause an electrically closed circuit and produce an alarm when pulled away from each other (see col. 2, line 46- col. 3, line 8 and col. 3, lines 20-64).

Regarding **claim 64**, as recited in claim 48, Sasakura fails to teach "releasable connector" from the portable device.

Pons teaches a "releasable connector" (separation of armed modules which are coupled together by fabric fastener or magnets, see col. 2, line 46- col. 3, line 8 and col. 6, lines 38-64).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Pons with the system of Sasakura for the benefit of achieving a system that includes two physical modules that cause an electrically closed circuit and

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produce an alarm when pulled away from each other (see col. 2, line 46- col. 3, line 8 and col. 3, lines 20-64)

Regarding **claim 51**, as recited in claims 64, Sasakura fails to teach the interruption of a closed conductive path via the releasable connector.

Pons teaches the interruption of a closed conductive path via the releasable connector (see col. 5, lines 20-47).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Pons with the system of Sasakura for the benefit of achieving a system that includes two physical modules that cause an electrically closed circuit and produce an alarm when pulled away from each other (see col. 2, line 46- col. 3, line 8 and col. 3, lines 20-64).

12. Claims 46 47,53,57,58 are rejected under U.S.C. 103(a) as being unpatentable over Sasakura in view of Pons and further in view of Rohrbach (U.S. 5,898,783), (hereinafter Rohrbach).

Regarding **claims 46 and 53**, as recited in claims 40 and 48, Sasakura teaches radio transmitter (items 31a and 33d in the cell phone 30, see Fig. 1)

However, the combination of Sasakura and Pons specifically fails to mention a cellular communications network and the control means is arranged to effect at least partial disablement of the portable device by sending a disabling message "to the

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network" instructing the network to disable normal operation of the telephone in the network.

Rohrbach further teaches that the data communication circuitry 200 transmits a code to the communication network via the mobile station 100 and in response to receiving a disable command, the disabling circuitry 220 is operative to prevent operation of the SIM card in the network (see col. 4, lines 14-25, col. 5, lines 13-31 and Figs. 2 & 3; i.e., the mobile phone operates to prevent the use of the sim card after obtain a disable command which is known to both the phone and the communication system that grants operational access to the phone).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Rohrbach into the system of Sasakura and Pons for the benefit of achieving a system that provides a way of remotely disabling SIMs and smartcard in the telecommunication network.

Regarding **claim 47**, as recited in claim 46, the combination of Sasakura and Pons fails to teach that the mobile telephone comprises a handset and a "replaceable card", which enables the handset to operate as a telephone in the network, and the network is responsive to the disabling message sent by the mobile telephone to disable the card from normal use in the network and/or to disable the handset from normal use in the network.

Rohrbach further teaches that the SIM card 110 or smart card cooperates with a mobile phone 100 to effect communication with the telecommunication network

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(see col. 3, lines 61-66).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Rohrbach into the system of Sasakura and Pons for the benefit of achieving a system that provides a way of remotely disabling SIMs and smartcard in the telecommunication network.

13. Claims 57,58 and 62 are rejected under U.S.C. 103(a) as being unpatentable over Sasakura in view of Rohrbach (U.S. 5,898,783), (hereinafter Rohrbach)

Regarding **claim 57**, as recited in claim 54, Sasakura fails to teach a replaceable card and the control means is arranged to effect partial disablement of the mobile telephone by locking the handset to the replaceable card.

Rohrbach further teaches that the SIM card 110 or smart card cooperates with a mobile phone 100 to effect communication with the telecommunication network (see col. 3, lines 61-66) and the incapacitation of the SIM card in the system (see col. 4, lines 13-26; which corresponds to "locking").

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Rohrbach into the system of Sasakura for the benefit of achieving a system that provides a way of remotely disabling SIMs and smartcard in the telecommunication network.

Regarding **claim 58**, as recited in claim 54, Sasakura teaches cell phone 30 (see Fig. 1); but the combination of Sasakura and Pons specifically fails to teach a cellular communications network and the control means is arranged to effect partial disablement of the portable device by "sending a disabling message to the network" instructing the network to disable normal operation of the telephone in the network.

Rohrbach further teaches that the data communication circuitry 200 transmits a code to the communication network via the mobile station 100 and in response to receiving a disable command, the disabling circuitry 220 is operative to prevent operation of the SIM card in the network (see col. 4, lines 14-25, col. 5, lines 13-31 and Figs. 2 & 3).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Rohrbach into the system of Sasakura for the benefit of achieving a system that provides a way of remotely disabling SIMs and smartcard in the telecommunication network.

Regarding **claim 62**, as recited in claim 59, Sasakura fails to teach a replaceable card and the control means is arranged to effect partial disablement of the mobile telephone by locking the handset to the replaceable card.

Rohrbach further teaches that the SIM card 110 or smart card cooperates with a mobile phone 100 to effect communication with the telecommunication network (see col. 3, lines 61-66) and the incapacitation of the SIM card in the system (see col. 4, lines 13-26; which corresponds to "locking").

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Rohrbach into the system of Sasakura for the benefit of achieving a system that provides a way of remotely disabling SIMs and smartcard in the telecommunication network.

14. Claims 65 and 66 are rejected under U.S.C. 103(a) as being unpatentable over Sasakura in view of Decotignie (U.S. 20010016484 A1), (hereinafter Decotignie).

Regarding **claims 65 and 66**, as recited in claims 54 and 59, Sasakura explicitly fails to teach the mobile telephone is capable of making emergency calls when it is partially disabled.

However, Decotignie teach the use of a mobile telephone which is capable of making emergency calls when is it in blocking state (see Par. 0027 and Fig. 1).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Decotignie into the system of Sasakura for the benefit of achieving a system that includes a device that can receive or make calls in an emergency situation when the device is blocked from making other usage (see Par. 0027 and Fig. 1).

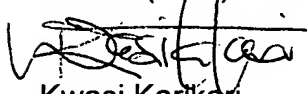
Conclusion

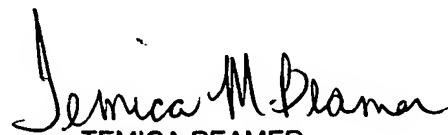
15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Helle (U.S. 6,662,023) teaches a method and approval for controlling and securing mobile phone that are lost, stolen or misused.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kwasi Karikari whose telephone number is 571-272-8566. The examiner can normally be reached on M-F (8 am - 4pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on 571-272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8566. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Kwasi Karikari
Patent Examiner.


TEMICA BEAMER
PRIMARY EXAMINER